



**U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

JANKUS  
05/15/89  
FABIO et al.

2301  
352530

Before the Board of Appeals

Wayne P. Bailey  
IBM Corp., Intellectual Property Law  
Dept., 932/815, Zip 4054  
11400 Burnet Road  
Austin, TX 78758

20 MAY 1993

RECEIVED

FEB 17 1994

BOARD OF PATENT APPEALS  
AND INTERFERENCES

94-1648

Examiner's Answer

Serial Number 07/352,530

Art Unit 2301

EXAMINER'S ANSWER

This is a response to appellant's brief on appeal filed November 25, 1992.

(1) Status of claims.

The statement of the status of claims contained in the brief is correct.

(2) Status of Amendments After Final.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(3) Summary of invention.

The summary of invention contained in the brief is correct.

(4) Issues.

The appellant's statement of the issues in the brief is correct.

(5) Grouping of claims.

Appellant's brief includes a statement that claims 1-27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(5) and (c)(6).

(6) Claims appealed.

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) Prior Art of record.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,885,717	BECK et al.	12-1989
-----------	-------------	---------

(8) New prior art.

No new prior art has been applied in this examiner's answer.

(9) Grounds of rejection.

The following ground(s) of rejection are applicable to the appealed claims.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 27 recites a computer program. This bare set of instructions fails to recite subject matter that falls within any statutory category. In this regard, a bare set of computer instructions does not set forth a sequence of steps which could be viewed as a statutory process. Such a computer language listing of instructions, when not implemented on a computing machine to accomplish a specific purpose, would not constitute a machine implemented process, but would constitute non-statutory subject matter as the mere idea or abstract intellectual concept of a programmer, or as a collection of printed matter. Thus, claim 27 is directed to non-statutory subject matter.

Claims 1-27 are rejected under 35 U.S.C. 103 as being unpatentable over Beck et al.

Beck et al. rendered obvious claim 1 by teaching the claimed

"means for representing a plurality of ... objects", "means for dynamically associating different ones" and "plurality of logical frame presentations based upon the data within each of said different ones" at fig. 5, items 27, 40, 41 and 53.

While Beck et al. teaches most features claimed, as outlined above, it is noted that "interface objects" is not explicitly taught. However, it would have been obvious to one of ordinary skill in the art at the time of the present invention to use interface objects because the reference discloses graphical representations of objects for the purpose of monitoring program execution. Thus, the graphical representations of objects can be construed as interface objects.

Claim 2 depends from independent claim 1 and further requires an interface object to represent at least one attribute of a system resource. Beck et al. teaches this feature at column 1, lines 62-65, and at column 3, lines 54-55.

Claim 3 depends from independent claim 1 and further requires representation of hierarchical relationships. Beck et al. teaches this feature at fig. 6, item 27.

Claim 4 depends from claim 2 and further requires a dynamic association according to hierarchical relationships. Beck et al. teaches this feature at fig. 6, item 21.

Claim 5 depends from independent claim 1 and further requires means for managing of a screen presentation. Beck et al. teaches this feature at column 8, lines 10-13.

Claim 6 depends from claim 2 and further requires means for utilizing a current value of a system resource attribute. Beck et al. teaches this feature at column 2, lines 6-9.

Claim 7 depends from claim 2 and further requires means for utilizing at least one instance of system resources for presentation. Beck et al. teaches this feature at column 14, line 63 to column 15, line 26.

Claim 8 depends from claim 7 and further requires means for allowing user to select instance. Beck et al. teaches this feature at column 14, line 63 to column 15, line 26.

Claim 9 depends from claim 2 and further requires means for utilizing a current value of a system resource attribute for validation. Beck et al. teaches this feature at column 14, line 63 to column 15, line 26.

Claim 10 depends from independent claim 1 and further requires means for constructing a command. Beck et al. teaches this feature at column 8, lines 1-5.

Claim 11 depends from claim 10 and further requires means for executing command. Beck et al. teaches this feature at column 8, line 7.

Claim 12 depends from claim 11 and further requires means for logging command for later reexecution. Beck et al. teaches this feature at column 8, lines 34-37.

Claim 13 depends from independent claim 1 and further requires means for constructing and executing a command based on a current state, a plurality of selections, and data within object. Beck et al. teaches this feature at fig. 6, item 60.

Claim 14 depends from independent claim 1 and further requires means for retrieving objects in response to selected item. Beck et al. teaches this feature at fig. 6, item 27.

Claim 15 depends from independent claim 1 and further requires means for iteratively presenting objects dependent upon selection. Beck et al. teaches this feature at figs. 3-12.

Claim 16 depends from independent claim 1 and further requires means for accessing an object from a plurality of screen presentations. Beck et al. teaches this feature at figs. 3-12.

Claim 17 depends from independent claim 1 and further

requires means for accessing a screen presentation from a plurality of objects. Beck et al. teaches this feature at figs. 3-12.

Claim 18 depends from independent claim 1 and further requires means for altering an object and reflecting it in the same session of execution. Beck et al. teaches this feature at column 4, lines 42-43.

Claim 19 depends from independent claim 1 and further requires means for altering object database by creating a new object. Beck et al. teaches this feature at column 4, lines 39-40.

Claim 20 depends from claim 3 and further requires means for entering hierarchy of objects. Beck et al. teaches this feature at column 11, lines 8-12, and at column 5, table 1.

Claim 21 ~~de~~ depends from independent claim 1 and further requires means for displaying presentations by a plurality of graphical libraries. Beck et al. teaches this feature at column 10, lines 1-6.

Claim 22 depends from independent claim 1 and further requires means for presenting items in at least one of a plurality of ways dependent upon a graphical context. Beck et



al. teaches this feature at fig. 6, item 27.

Claim 23 depends from independent claim 1 and further requires means for presenting items in at least one of a plurality of ways dependent upon a linguistic context. Beck et al. teaches this feature at fig. 6, item 22.

Claim 24 depends from independent claim 1 and further requires means for accessing a screen library having means for indicating items outside of a visual screen presentation. Beck et al. teaches this feature at fig. 6, item 60, and at column 12, lines 55-59.

Claim 25 depends from independent claim 1 and further requires means for providing a presentation dependent upon an access control policy. Beck et al. teaches this feature at fig. 1 item 18, and at column 3, lines 65-68.

Beck et al. rendered obvious claim 26 by teaching the claimed

"representing a plurality of ... objects in an object database", "dynamically associating different ones ... into a plurality of logical frame presentations based upon the data within each of said different ones" at fig. 5, items 27, 40, 41 and 53.

While Beck et al. teaches most features claimed, as outlined above, it is noted that "interface objects" is not explicitly taught. However, it would have been obvious to one of ordinary skill in the art at the time of the present invention to use interface objects because the reference discloses graphical representations of objects for the purpose of monitoring program execution. Thus, the graphical representation of objects can be construed as interface objects.


Claim 27 recites a "computer program." In this rejection, "computer program" is interpreted to mean the underlying process, and not the code itself.

Beck et al. rendered obvious claim 27 by teaching the claimed

"means for representing a plurality of ... objects in an object database", and "means for dynamically associating different ones ... into a plurality of logical frame presentations based upon the data within each of said different ones" at fig. 5, items 27, 40, 41 and 53.

While Beck et al. teaches most features claimed, as outlined above, it is noted that "interface objects" is not explicitly taught. However, it would have been obvious to one of ordinary skill in the art at the time of the present invention to use interface objects because the reference discloses graphical representations of objects for the purpose of monitoring program

execution. Thus, the graphical representations of objects can be construed as interface objects.

  
GARY V. HARKCOM  
SUPERVISORY PATENT EXAMINER  
ART UNIT 2307

(10) New Grounds of Rejection. APPROVED.

(A) This examiner's answer contains the following NEW GROUNDS OF REJECTION.

Claim 27 is rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter by analogy to the printed matter exception to 35 U.S.C. 101.

The following discussion of claim interpretation is offered.

#### DEFINITIONS

##### Definition of computer program, and computer compatible medium

Claim language is to be given its broadest reasonable interpretation. The present claim 27 requires a "computer compatible medium" and "computer program" residing on the medium. Each of these, given a broadest reasonable interpretation, would include any form of program code, and medium, compatible with a computer. This would include source code, pseudo code, flow charts, and other forms of both the program and the medium on which the program resides.

For example, a program printed on paper is compatible with a computer equipped with text recognition equipment, and therefore would be within the established meaning of "computer compatible medium" and "computer program."

As will be established in this Examiner's Answer, even had appellants amended the claim to be limited to a computer compatible program other than a program on paper, this would not save the claim from failing to pass several of the statutory requirements for patentability.

Appellants' attempt to avoid the printed matter exception by drafting the claim which does not read on a program printed on paper directs attention to the problems of the claim form being proposed in this application.

The claimed invention is directed toward nonstatutory subject matter by analogy to the printed matter exception to 35 U.S.C. 101.

Appellants would like to avoid claim 27 being interpreted as nothing more than characters printed on paper (the claimed computer program does not read on forms of writing compatible only with humans). Even if the claim were amended or interpreted to avoid a reading of the claim on mere characters on paper, the claim would still be nonstatutory by analogy to the printed matter exception.

The classic example of printed matter is characters printed on paper. Original works of authorship, often comprised of

characters on paper, are protectable by copyright law. Computer programs embodied as symbols on paper are often protected by copyright law.

Copyright law has recognized that original works of authorship may be fixed in a variety of tangible mediums of expression, and the purpose of protecting the work should not be thwarted by merely altering the tangible medium. This principle is embodied in 17 U.S.C.A 102:

"(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."

Patent law does not protect mere works of authorship. Just as copyright law has recognized that protection should not be circumvented by merely providing the work on another tangible medium, patent law should not protect, without more, mere works of authorship on differing tangible mediums.

That is not to say that a patent may not issue in which the claims include a work of authorship. Rather, that which is claimed must be more than a mere work of authorship on a tangible medium.

If the tangible medium merely fixes printed matter, and there is no new functionality demonstrated, then the tangible medium functions as that tangible medium functions with respect to most other printed matter thereon. This meets the underlying

criteria for the printed matter exception (i.e., no new functionality), and is consistent with the case law, as will be discussed below.

Put another way it is generally obvious to have a pattern on a substrate. It is obvious to have characters on paper. It is obvious to have tickets with printed matter thereon.

Where, however, it is demonstrated that the tangible medium/printed matter combination results in a new and unobvious functional relationship, a patent should issue. This new functional relationship could be exhibited in two ways.

First, a new functional relationship could be found between the printed matter and the tangible medium. Second, a new functional relationship could be found between the tangible medium and a device which uses the tangible medium. In either case, the new functional relationship results from the printed matter.

The present claim merely requires a "computer compatible medium." There is a pattern written on the medium which is referred to in the claim as a "computer program." The claim provides a description of what the patterns on the computer compatible medium would mean to a computer interpreting the patterns. The functions described in the claim are not performed.

Without more, this claim language merely describes abstractions fixed in a tangible medium, which is nothing more than printed matter. In substance, a description of particular

patterns on a tangible medium is indistinguishable from a description of printed matter on paper. By analogy to copyright, the printed matter exception to 35 USC 101 should be held nonstatutory by analogy to the printed matter exception to 35 USC 101.

(B) This examiner's answer contains the following NEW GROUNDS OF REJECTION.

35 U.S.C. 112 FIRST PARAGRAPH

The specification is objected to under 35 U.S.C. 112 first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth below in the objection to the specification.

Appellants have used means plus function language, as allowed under 35 USC 112, sixth paragraph. Such language is interpreted to cover "the corresponding structure, material, or acts described in the specification and equivalents thereof [for performing the recited function]."

The present claim only recites a "computer compatible medium" on which a "computer program" resides. Appellants have not disclosed how such a mere computer compatible medium, without

more, can carry out the functions recited in the means plus function language.

A mere computer compatible medium has not been disclosed which either performs the claimed functions or causes a computer to perform such functions.

A computer program on a computer compatible medium, without more, is incapable of function without being read and interpreted by a computer.

(C) This examiner's answer contains the following NEW GROUNDS OF REJECTION.

35 U.S.C. 112 SECOND PARAGRAPH

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Absent evidence to the contrary, it is assumed that appellants have claimed the subject matter which they regard as their invention. It is the burden of the Patent Office to show otherwise. In the present application, it is clear that appellants do not propose that a certain program on a disk is what they regard as their invention.



Appellants have invented particular computer-implemented interface object presenting apparatus which carries out particular interface object operations, not mere interface object programs on a computer compatible medium.

Alternatively, the claims are unclear for failing to claim the essential elements of the invention -- the claims are incomplete.

(D) This examiner's answer containing the following NEW GROUNDS OF REJECTION.

Claim 27 is rejected under 35 U.S.C. 103 as being unpatentable over the well-known data processing technique of storing a "computer program" on storage media for later use by a computer.

Official notice is taken that "computer program[s]" are commonly recorded or stored on a "computer compatible medium." This finding is supported by the fact that appellants' specification does not describe any computer compatible medium, but relies for enablement on what is common and well-known to persons of ordinary skill in the art.

The only difference between the claim and the prior art computer compatible media is the computer program recorded on the substrate. In printed matter cases, "[w]here the printed matter

is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The functional relationship must be a "new and nonobvious functional relationship." Gulack, 703 F.2d at 1386 217 USPQ at 404 (quoting In re Miller, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969)). By analogy to printed matter, where there is no new and nonobvious functional relationship between the "computer program" and the substrate, the "computer program" will not distinguish the claimed invention from the prior art in terms of patentability. See Ex parte Carver, 227 USPQ 465, 468 (Bd. App. 1985) (Examiner-in-Chief Lindquist, concurring). Here, there is no new and nonobvious functional relationship between the "computer program" and the substrate. The claims do not specify the nature of the substrate, but are so broad as to read on any substrate and any method of recording computer program information on the substrate. The substrate serves no other purpose than as a carrier or support for the computer program information. No new and nonobvious functional relationship between the "computer program" and the "computer compatible medium" has been described or claimed.

The concurring opinion of Examiners-in-Chief Messenheimer and Nusbaum in Carver has been interpreted by one commentator to "suggest that certain types of computer algorithms or programs might be effectively claimable as machine-readable signals recorded on a medium." Patents, Chisum, Donald S., 1.02[4].

This position is not adopted. Absent a showing of a new and nonobvious functional relationship between the "computer program" and "computer compatible medium" the "computer program" is not entitled to patentable weight in the obviousness determination.

In the present application there is no new functional relationship resulting from the interface object program merely residing on the computer compatible medium. The computer compatible medium is for holding information, and that is what it does. Nor do the claims create a combination which creates a novel functional relationship, as a result of the printed matter, between the device using the substrate and the substrate.

That is, no new functional relationship has been created by the combination of the interface object program (printed matter) and the computer compatible medium (substrate). And no new functional relationship has been created between the computer compatible medium and the computer as a result of the printed matter.

The new functional relationship from the combination of the printed matter and the device which uses the substrate should not be imputed to the functional relationship between the printed matter and the substrate, nor to the functional relationship between the substrate and the device associated with the substrate.

The claims could also be considered obvious because they could be considered to read on literally anything. A typical computer system has a disk operating system (DOS), as well as a

basic input/output system (BIOS). Each of these is a special purpose program for interpreting information in order to perform operations which manage parts of the computer system. These operations typically result from the computer reading information from a disk, and interpreting the information. When the computer interprets the information, that interpretation defines what the computer is at that moment in time.

The computer could be set up to read information, instead of from a disk, from virtually anything that stores information. The computer could also be set up to interpret that information to result in certain functions being performed. This means that virtually anything could be defined as "computer program" on a "computer compatible medium." Therefore, appellants' claim would read on anything which a computer could be set up to interpret in such a manner that novel functions are performed. The novelty, however, is in the actual performance of the operations, not all possible objects which a computer could interpret to result in those functions.

An example will illustrate the argument. Instead of the disk operating system, a computer is implemented with a vision operating system and apparatus which reads information from visible objects. The computer first detects an object, and then interprets the detected object. As a result of the interpretation, the computer performs certain operations corresponding to the respective object detected.

The objects to be detected are etched on a piece of marble.

The computer scans the marble, detects a circle, performs the operations associated with the circle, detects a square, performs the operations associated with the square, etc. The operations, when performed result in a patentable apparatus or method.

The claims directed toward the marble, however, merely recite a "computer program" for performing certain functions or for causing a computer to perform certain functions, on a computer compatible medium. Clearly, this "printed matter" would not be patentable.

Appellants have only invented the methods and apparatus which carry out the presenting of interface objects.

(11) Response to argument

Appellant's address the rejections at pages 6-29 of the Appeal Brief. Appellant's arguments will be addressed in the order presented by applicant.

(A) 35 U.S.C. 103

Group I (claims 1, 3, 13-17, 24, and 26)

With respect to appellants' argument at page 6, that the examiner has erred in rejecting the claims as a matter of law, the examiner respectfully disagrees.

Appellants correctly state that to aid in determining obviousness, inquiry must be made as to (1) the scope and content

of the prior art, (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) so-called "secondary considerations."

The examiner will address specifically items (2) and (3) because the level of ordinary skill in the art is essential in determining the differences between the prior art and the claims at issue.

For example, at pages 6-9, appellants argue that Beck fails to teach or suggest "dynamically associating ... based upon the data within each of said ... interface objects." Taking this recitation, it is incumbent upon the examiner to interpret this recitation in the broadest reasonable way that one of ordinary skill in the art would view it; and then to determine the differences between this interpretation and the prior art.

Taking the word "dynamically", it is clear that the meaning of "dynamically" is broad. It encompasses, in addition to appellants' interpretation of "active in nature", meanings including, pertaining to energy or power, functionality, and, in the computer data processing art - the designation of an event that occurs during the execution of a computer program. Taking the last meaning, it is clear that all events described in the Beck patent occur during the execution of a computer program, and are therefore dynamic. Beck teaches in the abstract that his system "creates a graphical representation of the sequences of messages sent during operation of an object-oriented program." Therefore, "dynamically", as reasonable interpreted by one of

ordinary skill in the art, is taught by Beck.

Now taking the phrase "dynamically associating", this is taken to mean associating during the execution of a computer program; and the "graphical representation of the sequence of messages", of Beck, clearly teaches association. The "representation", i.e., the item which stands in place of "the sequence of messages", is clearly associated with "the sequence of messages." Therefore, "dynamically associating", as interpreted by one of ordinary skill in the art, is taught by Beck.

The phrase "interface objects" is taken to mean any objects which facilitate interaction between a user and the computing system; with an object being a block of program instructions describing various procedures (methods) to be performed in response to messages sent to the object from another object (See Beck column 2, lines 62-66). The "graphical representation" of Beck satisfies this requirement. At column 3, lines 15-28 of Beck, Beck teaches this facilitation of interaction between user and computing system by reciting "so as to make the sequence of messages sent and methods performed by an object-oriented program easier to follow and comprehend." Therefore, "interface objects", as interpreted by one of ordinary skill in the art, is taught by Beck.

Finally, "based upon the data within each of said ... interface objects" is taught by Beck in his recitation of "When one object transmits a message to another object ... [the system]

... displays representations of the transmitting and receiving objects on a computer screen" (see the abstract of Beck). The "data" upon which the associations are based are the "messages" which are transmitted among the objects. Therefore, "based upon the data", as interpreted by one of ordinary skill in the art, is taught by Beck.

As can be seen from this detailed discussion, "dynamically associating ... based upon the data within each of said ... interface objects" is taught by Beck.

Therefore, appellants' arguments are not persuasive.

#### Group II (claims 2, 6-8)

At page 9, appellants argue that Beck fails to teach "attributes of system resources." However, a mouse is a system resource, and the activity of the mouse buttons can be considered attributes of the mouse and mouse buttons. Beck teaches this at column 14, line 66 to column 15, line 2.

#### Group III (claim 4)

At page 10, appellants argue that Beck fails to teach "dynamic association using hierarchical data stored within an object." Hierarchical data, given the broadest reasonable interpretation is merely an arrangement of data in a particular order. Beck teaches a particular order at column 12, lines 22-25, that of an order of execution of lines of code.



## Group IV (claim 5)

At page 10, appellants argue that Beck fails to teach managing of a screen presentation of the objects and a user interaction with the objects. However, figures 1-12 of Beck show various screen presentations for user interaction, and some form of management of these screen presentations is required and performed by the computer.

## Group V (claim 9)

At page 11, appellants argue that Beck fails to teach means for utilizing a current value of said ... attribute of said ... system resource for a validation of a user response. However, Beck teaches this feature at column 14, line 63 to column 15, line 26.

## Group VI (claims 10 and 11)

Appellants argue that Beck fails to teach dynamically constructing commands and constructing a command by associating a user input value with an option within the interface object. However, Beck teaches this feature at column 8, lines 1-7.

## Group VII (claim 12)

Appellants argue that Beck fails to teach means for logging said command for later execution. However, Beck teaches this at column 8, lines 34-37.

## Group VIII (claim 18)

Appellants argue that Beck fails to teach altering an object database from within the interface during a session of executing ... and ... reflecting said altered interface during said same session. However, Beck teaches this feature at column 4, lines 42-43.

## Group IX (claim 19)

Appellants argue that Beck fails to teach an interface object database by creating a new interface object. However, Beck teaches this at column 4, lines 39-40.

## Group X (claim 20)

Appellants argue that Beck fails to teach directly entering a hierarchy of objects. However, Beck teaches this at column 11, lines 8-12, and at column 5, table 1.

## Group XI (claim 21)

Appellants argue that Beck fails to teach displaying said logical frame presentations by a plurality of graphical libraries. However, Beck teaches this at column 10, lines 1-6.

## Group XII (claims 22 and 23)

Appellants argue that Beck fails to teach means within said interface objects, for representing items in said logical frame presentation dependent upon a graphical/linguistic context.

However, Beck teaches this at figure 6, items 22 and 27.

Group XIII (claim 25)

Appellants argue that Beck fails to teach an access control policy. However, Beck teaches this feature at figure 1, item 18, and at column 3, lines 65-68.

(B) 35 U.S.C. 101

Group XIV (claim 27)

At pages 19-20, appellants argue that appellants are not claiming an abstract concept, but rather the specific means for presenting items for selection by a user in a data processing system; and that each of the recited means resides on a computer compatible medium, which specifically recites a structural limitation.

However, the claim is expressly directed to a computer program or software intended to run on a computer, albeit claimed in functional terms as (i) means for representing a plurality of interface objects in an object database, and (ii) means for dynamically associating different ones of the interface objects with a plurality of logical frame presentations. The intention of implementing the program on a computer at some unspecified time still leaves the program unimplemented and non-executed the rest of the time; and thus is merely a programmers idea written on a computer compatible medium.

At pages 20-25 appellants argue that a computer program residing on a computer readable medium is both a "subcombination" of a machine and an article of manufacture; and that appellants' computer program claim is directed to a machine subcombination, i.e., the medium containing the recited "means for" limitations. However, if the medium merely fixes the pattern of instructions, i.e., the recited "means for" limitations, and there is not new functionality demonstrated, then the medium functions as that medium functions with respect to most other instructions or printed matter printed thereon. This meets the underlying criteria for the printer matter exception (i.e., no new functionality), and is consistent with case law.

With respect to appellants' argument that software is both an engineering product and the specification for that product, software, when not executing on a computer, is no more an engineering product than is a computer users manual. On the one hand, software comprises instructions written in a form and on a medium that is compatible for use on a computer, and a users manual comprises instructions written in a form and on a medium that is compatible with a user. The statutory machine or process occurs only when the computer actually executes the instructions or software. Only then do the recited "means for" limitations take effect, and the process becomes statutory under 101.

At the last paragraph of page 23, appellants argue that "appellants' are not claiming a medium having random indicia thereon, but rather a medium where the novel and nonobvious

selection and arrangement of the indicia, when used by a machine, results in specific novel and nonobvious claimed operations."

However, appellants' claim makes no recitation of "when used by a machine." Appellants seek patent protection for the medium with the arrangement of indicia thereon, whether executing on a computer or not. Therefore, appellants' arguments are not persuasive.

At pages 25-27, appellants' arguments are directed to the judicially defined mathematical algorithm exception. However, the claim is not rejected under the mathematical algorithm exception.

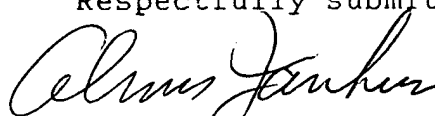
(12) Period of response to new grounds of rejection.

In view of the new grounds of rejection, appellant is given a period of TWO MONTHS from the mailing date of this examiner's answer within which to file a reply to any new ground of rejection. Such reply may include any amendment or material appropriate to the new ground of rejection. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected.

(13) Conclusion.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted



Almis Jankus

Patent Examiner

Art Unit 2301



GARY V. MARKCOM  
SUPERVISORY PATENT EXAMINER  
ART UNIT 2301